REMARKS

Claims 59-61, 63-102, and 104-116 are pending. Claims 91, 92 100, 101, 112 and 114 are withdrawn from consideration. No claims are amended, canceled or added by this amendment. Entry of this amendment is respectfully requested. Following entry of this amendment, claims 59-61, 63-102, and 104-116 will be pending

Request for rejoinder of withdrawn claims

Applicants thank the Examiner for acknowledging Applicant's request for rejoinder of withdrawn process claims that depend from or otherwise include all of the limitations of allowable product claims, in accordance with the provisions of MPEP § 821.04.

Obviousness type double patenting

Claims 59-61, 63-90, 93-99, 102, 104-111, 113 and 115-116 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46, 49-90, 93-99 and 101-104 of copending application no 11/535,003. Without conceding to the propriety of the rejection, Applicants request that this provisional rejection be placed in abeyance until allowable subject matter has been found..

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 59-61, 63-90, 93-99, 102, 104-111, 113 and 115-116 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In the rejection, the Examiner relies on the definition of amplifiable selectable gene, stating

> [t]he instant definition of an "amplifiable selectable gene" would appear to include any selectable marker because any given selectable marker gene can be amplified (i.e., additional copies of the gene are generated which survive in intrachromosomal or extrachromosomal form) by inclusion on a given replicon or by being operably linked to an amplifiable gene such as the dhft gene. It is unclear what characteristics a selectable gene would have so as to be considered a selectable gene which is **not amplifiable**. This issue is made even more confusing in that applicants recite an example of a selectable gene which applicants indicate is not generally considered to be amplifiable (the neomycin resistance gene (neo)); however, the prior art (see for example, US Patent 5, 919,635, column 9, lines 11-33) lists the neomycin resistance gene as a **preferred amplifiable genetic marker**. (emphasis in original).

Applicants respectfully traverse this rejection.

Legal standard

The test for definiteness under 35 U.S.C. § 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). "Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite. *Metabolite Labs., Inc. v. Laboratory Corp. of America Holdings*, 370 F3d 1354, 71 USPQ2d 1081 (Fed. Cir. 2004) (citing *Exxon Research & Eng'g Co. v United States*, 265 F3d 1371, 1375 (Fed. Cir 2001).

"Amplifiable selectable gene" and "selectable gene that is not amplifiable" have different meanings

The specification makes it clear that the phrases "amplifiable selectable gene" and "selectable gene that is not amplifiable" have different meanings, contrary to the Examiner's assertion that the definition of amplifiable selectable gene "would appear to include any selectable marker". Indeed, the definition of amplifiable selectable gene provides an example of a selectable gene "which is generally not considered to be amplifiable", thus underscoring that the term "amplifiable selectable gene" is not intended to encompass all selectable genes.

Further review of the specification confirms that the phrase "amplifiable selectable genes" does not encompass all selectable genes, as the specification repeatedly references "amplifiable selectable genes" as a subset of "selectable genes". See, e.g., spec. at page 14, lines 203 ("[t]he selection agent can also be the amplifying agent if the selectable marker gene relied on is an amplifiable selectable marker"); at page 12, line 2 ("[t]he selectable marker genes used herein including the amplifiable selectable genes..."); and at page 22, lines 13-14 ([a]n "amplifiable selectable gene" has the properties of a selectable marker gene as defined above, but additionally can be amplified...". Thus, it is evident that the phrase "amplifiable selectable gene" does not encompass all selectable markers, contrary to the Examiner's statement in the rejection.

Applicants disagree with the Examiner's statement that the following sentence in the definition of amplifiable selectable gene lends "confusion" to the definition of amplifiable selectable marker: "[a]n example of a selectable gene which is generally not considered to be an amplifiable gene is the neomycin resistance gene." As noted above, the statement that the neomycin resistance gene is "a selectable gene which is generally not considered to be an amplifiable gene" underscores that Applicants did not intend that the phrase "amplifiable selectable gene" to encompass all selectable genes. One of skill in the art reading the definition of amplifiable selectable gene and the specification as a whole would reasonably understand the

phrases "amplifiable selectable gene" and "selectable gene that is not amplifiable" to have different meanings (and thus that the term "amplifiable selectable gene" is not intended to encompass all selectable genes), even in view of the statement in US Patent 5,919,635 that "the neomycin resistance gene is a preferred amplifiable genetic marker". Accordingly, Applicants respectfully submit that the meaning of amplifiable selectable gene is clear. Withdrawal of this rejection is respectfully requested.

Moreover, Applicants note that Thilly (*Mammalian Cell technology*, Butterworth Publishers, Stoneham, Mass.) is cited as authority in USP 5,919,635 for the statement that the neomycin resistance marker is amplifiable. However, upon review of Thilly's discussion of gene amplification (pages 34-39) and all references to the neomycin resistance marker in Thilly (pages 47, 48, 52-54), Applicants were unable to find support in for this statement. Pages 34-39, 47, 48 and 52-54 of Thilly are attached herewith as Appendix A. Applicants further note that Kaufman, Methods in Enzymology (1990) 185:537-566 at 558-559 states that the neomycin resistance marker has not been demonstrated to be amplifiable. Kaufman is attached herewith as Appendix B. Withdrawal of this rejection is respectfully requested.

There is no support in the specification for the contention that inclusion on a replicon with or operable linkage to an amplifiable gene renders all selectable genes "amplifiable selectable genes" as that term is defined in the present specification

The Examiner states that [t]he instant definition of an "amplifiable selectable gene" would appear to include any selectable marker because any given selectable marker gene can be *amplified (i.e., additional copies of the gene are generated which survive in intrachromosomal or extrachromosomal form)* by inclusion on a given replicon or by being operably linked to an amplifiable gene such as the dhft gene" (emphasis added). Applicants have reviewed the specification and can find no support for the Examiner's statement that one of skill in the art would view any selectable marker gene as an "amplifiable selectable gene" by virtue of its inclusion on a given replicon with an amplifiable gene or by being operably linked to an amplifiable gene.

By contrast, Applicants note that the definition of amplifiable selectable marker states that "an amplifiable selectable gene can be amplified . . . under appropriate conditions". Review of the specification indicates that "under appropriate conditions" refers to culture conditions for selection and amplification of the amplifiable selectable gene. See, e.g., specification at page 20, lines 19-17; see also definition of selectable marker gene and amplifying agent (stating that selectable genes (which include amplifiable selectable genes) are genes that allow cells carrying the gene to be specifically selected . . . in the presence of a corresponding selection agent, and

noting that an amplifying agent is an agent for amplifying copies of the amplifiable gene). Thus, the definition restricts amplifiable selectable genes to a gene that is capable of being selected and amplified using a corresponding amplifying agent. A selectable marker that is not amplifiable is clearly not capable of being amplified using a corresponding amplifying agent. Withdrawal of this rejection is respectfully requested.

For the above-stated reasons, withdrawal of this rejection is respectfully requested.

SUMMARY

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is strongly encouraged to call the undersigned at the number indicated below.

In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Respectfully submitted,
GENENTECH, INC.

Date: 8-6-07

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